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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/577,036

04/24/2006

Kazunori Yamazaki

AIA-116-PCT

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SNIDER & ASSOCIATES

P. O. BOX 27613

WASHINGTON, DC 20038-7613

EXAMINER

HUYNH, CARLIC K

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

02/21/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,036	<b>Applicant(s)</b> YAMAZAKI ET AL.	
	<b>Examiner</b> Carlic K. Huynh	<b>Art Unit</b> 1612	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :24 April 2006 and 07 December 2006.

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-4 are pending in the application in response to the restriction requirement submitted on October 18, 2007. Accordingly, claims 1-4 are being examined on the merits herein.

### ***Election/Restrictions***

2. Applicant's election without traverse of: (1) the compound of Formula (II) as the species of a compound of formula (I) in the reply filed on November 13, 2007 is acknowledged.

Accordingly, claims 1-4 are examined on the merits herein.

The election/restriction requirement is deemed proper and is made FINAL.

Claims 1-4 are directed to a cosmetic composition and thus intended use is not given any patentable weight.

### ***Information Disclosure Statement***

The Information Disclosure Statements submitted on April, 24, 2006 and December 7, 2006 are acknowledged.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract needs to be reformatted into a single paragraph. Appropriate correction is required. See MPEP 37 CFR § 1.72 (b).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The "linear or branched fatty acid residue" and the "benzoic acid residue" in claim 1 and the "2-ethylhexanoic acid residue" and "benzoic acid residue" in claim 2 renders the instant claims indefinite because it is not clear what "residue" refers to, where the term "residue" is not defined in the instant specification.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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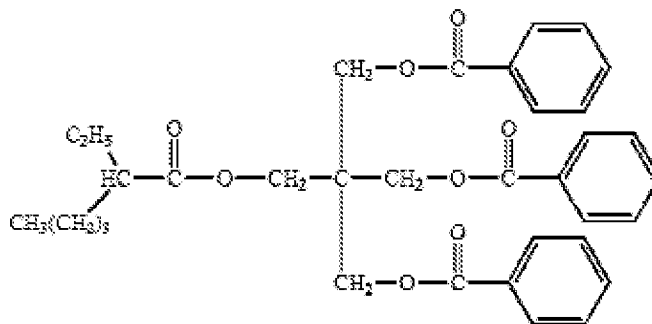
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

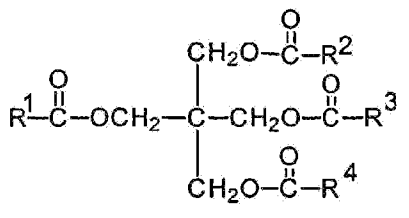
U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977 A1 as cited in the IDS).

It is noted the instant compound is of formula (II),



Mitsumatsu et al. teach a hair care composition comprising a pentaerythritol ester oil of the formula,



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where  $R^1$  is a branched alkyl aryl, and  $R^2$ ,  $R^3$ , and  $R^4$  are aryl (page 27, lines 18-22). The pentaerythritol ester oil is from about 0.1% to about 10% of the composition (page 26, lines 26-29).

It is noted that hair care compositions are cosmetic compositions and thus it would be obvious that the hair care compositions of Mitsumatsu et al. are cosmetic compositions.

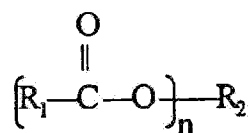
Regarding the concentration of the pentaerythritol ester oil in instant claim 3, Mitsumatsu et al. teach that the weight of the pentaerythritol ester oil is from about 0.1% to about 10% of the composition (page 26, lines 26-29), which closely meets the concentration of the pentaerythritol ester oil in the composition set forth in instant claim 3. It is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the pentaerythritol ester oil provided in a composition, according to the guidance set forth in Mitsumatsu et al., to provide a composition having desired pentaerythritol ester oil content. It is noted that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 223, 235 (CCPA 1955).

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 02/19977 A1 as cited in the IDS) as applied to claims 1-3 above, in view of Healy et al. (WO 00/26285 as cited in the IDS).

Mitsumatsu et al. do not explicitly teach lipstick.

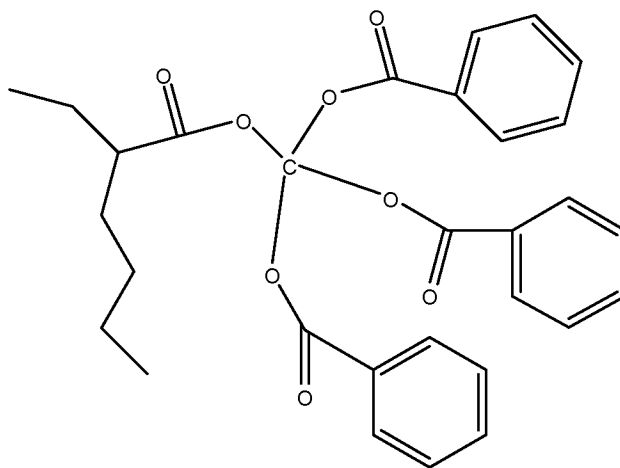
Healy et al. teach compound of the formula,

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where n is 4, R<sub>1</sub> is independently a phenol or hydrocarbyl, and R<sub>2</sub> is a hydrocarbyl (page 11, lines 4-17). Hydrocarbyl is known in the art to be any hydrocarbon such as methyl or phenyl and thus it would be obvious to the skilled artisan the hydrocarbyl can be a branch alkyl group.

Accordingly, the compound of Healy et al. can be the following,



Thus Healy et al. teach compounds that are structural homologs of the instantly claimed compounds, i.e., they differ only by CH<sub>2</sub> groups. The instant compounds are structural homologs of the reference compounds when n is 4, R<sub>1</sub> is independently a phenol or hydrocarbyl, and R<sub>2</sub> is a hydrocarbyl. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. *In re Hass*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950).



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Healy et al. further teach the compound may be used to make cosmetics (page 3, lines 9-10). Since Healy et al. teach cosmetic and since cosmetics may be a number of products such as hair care compositions or lipstick, it would be obvious to one skilled in the art that the cosmetic composition of Healy et al can be lipstick and a hair care composition.

Accordingly, absence the showing of unexpected results, it would have been obvious to a person of skill in the art at the time of the invention to employ the compounds of Mitsumatsu et al. to be made into a lipstick because the compounds of Healy et al. teach pentaerythritol compounds and according to Healy et al., pentaerythritol compounds can be made into lipsticks and hair care compositions.

The motivation to combine the compounds of Mitsumatsu et al. to the compounds of Healy et al. is that compounds of Healy et al. are pentaerythritol compounds and such compounds can be used to make lipsticks and hair care compositions.

### ***Conclusion***

7. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlie K. Huynh whose telephone number is 571-272-5574. The examiner can normally be reached on Monday to Friday, 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gollamudi S Kishore, Ph.D/  
Primary Examiner, Art Unit 1612

ckh